

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Colleen C. LUBKING et al.)	Group Art Unit: 3694
)	
Application No.: 09/882,304)	Examiner: MILEF, Elda G.
)	
Filed: June 18, 2001)	Confirmation No.: 6864
)	
For: METHOD AND SYSTEM FOR)	
OFFERING FINANCIAL)	
PRODUCTS BASED ON A)	
CUSTOMER'S DETERMINED)	
LIFE STATUS)	

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SURREPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Surreply Brief responsive to the Examiner's Answer mailed on July 15, 2010. Appellants respectfully submit the following remarks.

REMARKS

In the Examiner's Answer dated June 29, 2010, the Examiner set forth new grounds of rejection not previously on record. Appellants respectfully submit the following remarks in response to the Examiner's new grounds of rejection.

I. Status of Appeal

Appellants filed their initial appeal brief more than three years ago, on June 29, 2007. The Examiner's first Answer was sent September 18, 2007, and Appellants followed with a reply brief on November 19, 2007. On December 3, 2008, the Board of Patent Appeals and Interferences ("Board") remanded the appeal to the Examiner for further consideration. The Examiner sent a second Examiner's Answer December 9, 2008. The Board once again remanded the appeal to the Examiner on June 3, 2010. In response, the Examiner sent a third Examiner's Answer July 15, 2010.¹ This Surreply Brief is in response to the new grounds for rejection noted therein.²

II. Response to Examiner's Arguments in the Examiner's Answer

The Examiner's Answer directs Appellants to respond to the new grounds for rejections, identified as new in Section 6, beginning on page 2 of the Examiner's Answer and maintained in Section 9, beginning on page 7 of the Examiner's Answer. See Examiner's Answer at 18. Appellants understand that the "new ground of rejection" refers to the rejection of claim 17 under 35 U.S.C. § 112, 2nd paragraph. *Id.* Thus, as to already alleged grounds for rejection, specifically those made under 35 U.S.C. § 103(a),

¹ Unless specifically stated otherwise, "Examiner's Answer" refers to the Examiner's Answer dated July 15, 2010.

² The December 9, 2008 Examiner's Answer alleged multiple claim rejections under 35 U.S.C. § 101. These rejections are no longer present in the Examiner's Answer and therefore Appellants deem the rejections to be withdrawn.

Appellants direct the Board to their original Appeal Brief filed Jun 29, 2006, and Reply filed, November 19, 2007.

Although Appellants disagree with the Examiner's Answer and allegations that claim 17, as written, does not conform to 35 U.S.C. § 112, 2nd paragraph, to clarify the issues on appeal, Appellants withdraw claim 17 and 23 without prejudice or disclaimer for purposes of this appeal.

III. Status of Claims Regarding the Rejection Under 35 U.S.C. § 103(a)

In section 9 of the Examiner's Answer, the Examiner notes,

The after final amendment submitted by the Appellants on 1/29/2007 included the cancellation of claims 5, 6, 21, 22, 28, 29 which were rolled into the independent claims 1, 17, and 24. The rejection of the amended independent claims would therefore include the secondary reference and are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran in view of Kunzle.

Examiner's Answer at 7.

To clarify the record for appeal, the remarks above are understood to mean that the remaining issues for this appeal are the rejection of claims 1, 7, 13, 14, 24, and 30-33 under 35 U.S.C. § 103(a) over Moran in view of Kunzle. Specifically, Appellants believe the Examiner intends that the previous rejections of claims 1, 14, 17, 24, and 31-33 over Moran are moot based on the Amendment After Final filed on January 29, 2007, amending claims 1, 17, and 24, and cancelling claims 5-6, 21-22, and 28-29.³ See Examiner's Answer at 12-14.

³ As Appellants understand, the Amendment After Final was entered according to the February 7, 2007 "Advisory Action Before the Filing of an Appeal Brief."

Thus, Appellants understand that claims 1, 7, 13, 14, 24, and 30-33 remain pending, claims 17 and 23 are withdrawn from the appeal without prejudice or disclaimer, and claims 2-6, 8-12, 15-16, 18-22, and 25-29 are cancelled.

If Appellants' understanding is incorrect, Appellants request clarification of the status of the issues on Appeal. In short, Appellants intend to maintain their appeal as to the remaining rejections under 35 U.S.C. § 103(a) and do not intend to reopen prosecution as to the pending claims or waive any right to pursue the appeal of the Section 103 rejections.

Accordingly, in response to the outstanding rejections under Section 103(a) over Moran in view of Kunzle, Appellants incorporate by reference the arguments and remarks made in the Appeal Brief filed June 29, 2007, and the Reply Brief filed November 19, 2007.

IV. Conclusion

For the reasons set forth above, supplementing those presented in the Appeal Brief filed on June 29, 2007, and the Reply Brief filed, November 19, 2007, Appellants respectfully request of the Board the reversal of the Examiner's rejection of claims 1, 7, 13, 14, 24, and 30-33.

If there are any fees due that are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 15, 2010

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